

ARGUMENTS/REMARKS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action, and amended as necessary to more clearly and particularly describe and claim the subject matter, which applicants regard as the invention.

Applicant's representative notes that continuity information has been provided in the ADS filed in this case, thus meeting the requirement of 37 CFR 1.78.

Claims 1–19 remain in this application. Claims 10–14 and 16–19 have been allowed. Claims 20–22 have been added to claim additional features of the invention supported by Figure 1C.

The Examiner objected to claims 4, 7 and 9, but indicated that they would be allowable if put into independent format. Applicant has not yet done so, because applicant believes that the parent claims are allowable for the reasons discussed below.

Applicant's representative recognizes the rejection of claims 1–19 for judicially created Double Patenting and is providing a Terminal Disclaimer for U.S. Pat. No. 6,728,558 B1 herewith.

Claims 1–3, 5 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weadon (U.S. 6,226,501) in view of Johnson (U.S. 6,463,262). Claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over Weadon and Johnson in view of Roeder (U.S. 5,491,745). For the following reasons, the rejections are respectfully traversed.

Claim 1 recites a portable telephone apparatus comprising a cover "slidably connected to said body, said cover having one or more second key entry means, each of said one or more second key entry means capable of activating a corresponding one of said first key entry means when said cover is in a closed position." Claims 8 and 15 recite similar limitations. The Examiner admits that Weadon does not suggest this limitation of claims 1 and 8. Instead, the Examiner

cites Johnson as teaching this limitation of the claim. However, the Examiner does not provide sufficient motivation for combining Johnson with Weadon.

The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not legally sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not, by itself, sufficient to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such motivation or suggestion in the reference, and the Examiner provides no references supporting any motivation to modify the reference. Instead, the Examiner merely states that the motivation is provided by a desire to "provide a tactile improvement for the user which he can apply substantial (sic) the same force to one of the parts to move it a certain distance relative to other (sic), irrespective of its starting position."

This statement is nothing more than a benefit provided by the Johnson reference. This is hardly any motivation for adding the sliding cover feature of Johnson to the primary reference. In fact, Weadon already has a flip cover. There is no reason for Weadon to add a different cover, which would substantially change the principle of operation of the Weadon device, and might take away any marketing advantage provided by a flip cover. The Examiner is attempting to substitute a cover that operates by one method with a cover that operates by a substantially different method.

Furthermore, the Johnson cover cannot merely be substituted for the Weadon cover, because the Weadon cover includes secondary keys whereas the Johnson cover does not. Thus, the Johnson cover must first be modified before it can be utilized in the Weadon device. However, neither reference teaches any manner of modification for the slidable cover of Johnson to make it acceptable to the Weadon device. Weadon only discusses the features of a flip cover with secondary keys,

whereas Johnson is totally silent as to the subject of secondary keys on a cover. Thus, even if combined, the references do not teach how to design a slidable cover to include secondary keys. Only the application provides such a teaching, but using the teachings of the application are improper hindsight reasoning, and clearly improper.

Merely listing an advantage of the combination is not sufficient, and motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph). Accordingly, the rejection is improper and thus claims 1, 8 and 15 are patentable over the references. Claims 2–4, being dependent on claim 1, directly or indirectly, are patentable over the references for at least the same reasons as the parent claim.

Furthermore, claim 2 recites the apparatus “further comprising cover opening/closing state detecting means, wherein at least one operation is performed when said cover opening/closing state detecting means detects that said cover is slid opened or slid closed.” Claim 5 recites similar limitations. The Examiner states that Weadon teaches this claim limitation, but the Examiner points to no citation supporting such a statement. Applicant’s representative could find no such teaching in the reference. Accordingly, claims 2 and 5 are patentable over the references for this reason as well.

Claim 3 recites that the body of said apparatus further includes a “first microphone and said cover further including a second microphone.” Claim 5 recites similar limitations. The Examiner cites Weadon as teaching a slot in its cover, stating that the slot “functions as a second microphone.” This is not a proper rejection. The claim specifically recites a second microphone. This is a structural limitation. The Examiner cannot cite a “functional equivalent” to teach a different structure. Furthermore, a slot is clearly not a functional equivalent to a microphone, as a microphone clearly has active conversion capability (it converts sound to electrical signals), whereas a slot clearly does not. Thus, claims 3 and 5 are patentable over the references for this reason as well.

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Weadon and Johnson in view of Norman (U.S. 6,037,027). For the following reasons, the rejection is respectfully traversed.

Claim 6 depends on claim 5. Norman does not overcome the shortcomings of Weadon discussed above, and thus claim 6 is patentable over the references for at least the same reason as claim 5. Furthermore, the Examiner has not provided the proper motivation for combining Norman with Weadon and Johnson. Thus, claim 6 is patentable over the reference for this reason as well.

Finally, new claim 20 recites additional limitations that are not found in any of the references, and thus claim 20 is patentable over the references. Claims 21 and 22, which depend on claim 20, are thus patentable over the references for at least the same reasons as claim 20.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33023US1.

Respectfully submitted,
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